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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/310,638	05/12/99	SOREQ	H 2391.00096

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HM12/0905

EXAMINER

CROUCH, D

ART UNIT

PAPER NUMBER

1632

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DATE MAILED:

09/05/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.
09/310,638

Applicant(s)
Soreq et al

Examiner
Deborah Cruch

Group Art Unit
1632



☐ Responsive to communication(s) filed on _____

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one (1) month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-25 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-25 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 1632

Applicant should review claims 23 and 24 for claim dependency.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-10, drawn to DNA, vector, and cell, classified in class 435, subclass 320.1.
- II. Claims 11-14, 17-20 and 23-25, drawn to transgenic animal and a transgenic animal assay system, classified in class 800, subclass 13.
- III. Claims 15-16, drawn to acetylcholinesterase, classified in class 435, subclass 196.
- IV. Claims 21 and 22, drawn to method of treatment by administering antisense oligonucleotides, classified in class 514, subclass 44.

The inventions are distinct, each from the other because:

Inventions I and II are distinct because they are of separate uses. The DNA of invention I can be used to produce acetylcholinesterase in vitro. The transgenic animals of invention II can be used as an assay system for studying acetylcholinesterases physiological actions in vivo.

Inventions I and III are distinct because they are of separate uses. The DNA of invention I can be used to produce acetylcholinesterase in vitro. The acetylcholinesterase of invention III can be used as an assay in a substrate for transferase activity.

Inventions I and IV are mutually exclusive and independent invention. The DNA of invention is not required for the implementation of the method of treatment of invention IV.

Inventions II and III are distinct as they are of separate uses. The transgenic animal of invention II can be used to study acetylcholinesterase activity in vivo. The acetylcholinesterase of invention III can be used as a substrate for transferase activity.

Inventions II and IV are mutually exclusive and independent inventions. The transgenic animal of invention II is not required for the implementation of the method of treatment of invention IV.

Inventions III and IV mutually exclusive and independent inventions. The acetylcholinesterase of invention III is not required for the implementation of the method of treatment of invention IV.

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The inventions are distinct, each from the other because:

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

A telephone call was made to Mr. Ken Kohn on July 24, 2000 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah Crouch, Ph.D. whose telephone number is (703) 308-1126.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

The fax number is (703) 308-4242.



DEBORAH CROUCH
PRIMARY EXAMINER
GROUP 1200-1630

Dr. D. Crouch
September 2, 2000